

Appl. No. 10/037,632  
Amdt. dated November 3, 2003  
Reply to Office Action of July 2, 2003

## REMARKS

Upon entry of the foregoing amendment, claims 9, 11, 12 and new claims 24 through 36 are pending in the application. Of the pending claims, claims 9, 24, 31 and 36 are independent. Claims 1-8, and 13-23 have been cancelled.

The Office Action states in paragraph 2 that the limitation “wherein the article of manufacture is assembled prior to assembly to roof rafters” is given little to no patentable weight. The Examiner is respectfully reminded that limitations in a preamble must be given patentable weight when they are necessary to give meaning to the claim and define the invention. MPEP 2111.02. In such cases, “there is no meaningful distinction between the claim preamble and the rest of the claim, for only together do they comprise the ‘claim.’” Pitney Bowes, Inc. v. Hewlett-Packard Co., 51 U.S.P.Q. 2d 1161, 1166 (Fed. Cir. 1999).

Moreover, “it is well established that product claims may include process steps to wholly or partially define the claimed product.” In re Luck and Gainer, 177 U.S.P.Q. 523, 525 (C.C.P.A. 1973) (citing In re Brown, 173 U.S.P.Q. 685 (C.C.P.A. 1972)). In this case, Applicant’s process limitation partially defines the invention. Following the general rule of claim interpretation, “every limitation positively recited in a claim *must be given effect* in order to determine what subject matter that claim defines.” In re Wilder, 166 U.S.P.Q. 545, 548 (C.C.P.A. 1970) (emphasis added).

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***I. Claim Rejections under 35 U.S.C. § 112***

Claims 9 and 14 have been rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. Claim 9 has been amended, and claim 14 has been cancelled.

***II. Rejections under 35 U.S.C. § 103***

Claims 9-12, 14-17, and 19-22 have been rejected as being unpatentable over the Simpson et al. (5,096,759) patent in view of Harness (4,755,567). Claims 14-17 and 19-22 have been cancelled. Claim 9 has been clarified to recite:

a vapor, water and ice resistant layer secured to one face of the sheathing panel during manufacture of the article, said layer being secured at one longitudinal edge of said sheathing panel and extending completely along said one longitudinal edge and no further; and the vapor, water and ice resistant layer being constructed of a material that seals around fasteners passing through said layer and said sheathing panel to secure the same in place on roof rafters.

To be unpatentable under Section 103, the cited references must teach or suggest all of the claim limitations. None of the cited references disclose these limitations. Therefore, 9-12 must be viewed as non-obvious. Applicant respectfully requests that this claim rejection be withdrawn.

Additionally, new claims 24-36 have been added. New claims 24-36 include the limitation “a vapor, water and ice resistant layer being securely attached to the sheathing panel prior to assembling the sheathing panel to the roof rafters.” To be unpatentable under Section 103, the cited references must teach or suggest all of the claim limitations. None of the cited

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references disclose this limitation. Therefore, new claims 24-36 must be viewed as non-obvious.

Applicant respectfully requests that this claim rejection be withdrawn.

Even if the Examiner were to establish a prima facie case of obviousness, Applicant respectfully submits evidence of a secondary consideration establishing non-obviousness by way of declaration. Applicant's declaration is attached hereto as Exhibit A. Applicant's declaration establishes that there has been a long felt but unresolved need for the claim invention. Such a secondary consideration is evidence of non-obviousness.

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***III. Conclusion***

Accordingly, Applicant respectfully submits claims 9-12, and 24-36 are now in condition for allowance. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, he is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,



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